

Serial No. 10/782,013

- 4 -

51404sh

REMARKS

By this amendment, claims 8 and 9 have been amended, and new claim 16 has been added, leaving claims 8-16 now pending in this application, and these claims are presented for consideration by the Examiner.

Claims 8-19 were rejected under 35 U.S.C. §102(b) over Caulkins. By this amendment, the limitation of "structural plastic" has been included in claim 8, clearly distinguishing over this reference for that reason alone. Anticipation may be established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Systems, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). Moreover, anticipation requires the presence of all elements of a claimed invention as arranged in the claim, such that a disclosure "that 'almost' meets that standard does not 'anticipate'." Connell v. Sears, Roebuck Co., 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983). In this case, given that all of Caulkins' embodiments include a flexible bag, anticipation is precluded.

Claims 8, 9 and 15 were rejected under 35 U.S.C. §102(b) over Gildea. However, with the amendments of claim 8, particularly those pertaining to article geometry, anticipation is precluded here as well.

Claim 11 was rejected under 35 U.S.C. §103(a) over Caulkins in view of Hathorn. The Examiner concedes that Caulkins does not disclose a lighted message, but argues that it would have been obvious to combine Caulkins and Hathorn "in order to more effectively attract the attention of passersby." While this may be true, it is well settled that in rejecting claims under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to combine the cited references to arrive at Applicant's claimed invention. There must be something *in the prior art* that suggests the proposed combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior-art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999). In this case, given that Caulkins appears to use a clear plastic sheet to show signage covered thereby, and is silent with

Serial No. 10/782,013

- 5 -

51404sh

respect to any advantages gained through lighting, prima facie obviousness has not been established.

Claims 12 and 14 stand rejected under 35 U.S.C. §103(a) over Caulkins in view of Pynenburg et al. With regard to claim 12, the Examiner concedes that Caulkins does not utilize magnetic letters, and with respect to claim 14, the Examiner concedes that a marker surface is not provided. However, as with the rejection of claim 11, above, given that there is no teaching or suggestion to combine the references cited by the Examiner, prima facie obviousness has not been established. The same is true of claim 13, which is rejected under 35 U.S.C. §103(a) over Caulkins in view of French.

Based upon the foregoing amendments and comments, Applicant believes all pending claims are in condition for allowance. Questions regarding this application may be directed to the undersigned attorney by telephone, facsimile or electronic mail.

Respectfully submitted,

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